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EXAMINER	
MCCORMICK, GABRIELLE A	

ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/791,961	MEYER, ALLEN W.	
	Examiner	Art Unit	
	Gabrielle McCormick	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-13,15-25 and 27-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-13, 15-25, 27-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on January 21, 2009.

2. Claims 1, 4, 11-13, 17-18, 25 and 29 have been amended.

3. Claims 32 and 33 have been added.

4. Claims 1-4, 6-13, 15-25 and 27-33 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 21, 2009 has been entered.

Previous Claim Objections

6. Applicant has amended claim 4 to correct the dependency. The objection is withdrawn.

7. The Examiner further thanks the Applicant for his careful consideration of trademarks and their use. The previous objection is withdrawn.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 27 contains the phrase "the Post-It® note media". This phrase lacks proper antecedent basis. Based on the current amendments to the claims, the Examiner will understand the claim to refer to the adhesive-backed paper note of claim 25.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. **Claims 1-4, 6-12, 18, 27 and 29-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spain (US Pat. No. 6,056,195), in view of Rhodes (US Pub. No. 2004/0153969) in view of Hoffman (US Pat. No. 5,682,695).

13. **Claims 1, 2, 6, 7, 8, 10 and 29:** Spain discloses

- *capturing discrete portions of information with a computer keyboard;* (C2; L46-53 and Fig. 1A; includes *textual description*)
- *generating a note from each of the discrete portions of information each note includes visually perceptible note information and a duplicate computer readable symbology of the note information;* (Fig. 1A)
- *printing the note on an adhesive-backed paper;* (C3; L33-35 and C3; L67 – C4; L2)

14. Spain does not disclose *a meeting; moving the notes to a selected repository; organizing the notes in the selected repository to obtain organized notes; scanning each of the computer readable symbologies on each of the organized notes to obtain note information* or *placing the*

note information into one or more selected computer software applications. However, as Spain is directed to generation of label containing barcodes and associated text, it is obvious that the generated labels are moved (applied to a product) and scanned such that the note information is placed in a computer software application. Spain does not disclose the use of the barcoded labels that its invention produces, however, the use of such labels to track information on products is old and well known and is an obvious expansion of Spain's system.

15. Rhodes discloses a note taking system that incorporates information captured from the event (i.e., a meeting; P[0023]) that a user would like to integrate with the user's notes. (Abstract). Information can be captured by scanning barcodes printed on paper notes to access electronic information corresponding to the barcode. The information is output to the user's device. (P[0121]). The user's note taking device is used to read a barcode. (P[0050]). The system allows a user to capture information to integrate (i.e., place into a selected computer application) with the user's notes. (P[0041], [0123-0124] and Fig. 6B).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of the printed barcode labels in a meeting environment, as disclosed by Rhodes in the system disclosed by Spain, for the motivation of providing an additional use of barcoded labels. It is obvious that the system of Rhodes relies on barcoding technology to create the barcodes associated with the electronic content. Therefore, it is obvious that the systems of Spain and Rhodes can be combined to create barcoded labels for corresponding to work papers associated with a meeting environment.

17. Further, it would have been obvious to one of ordinary skill in the art to include Spain's system of generating label media comprising barcodes and text with Rhodes' use of barcodes for tracking information in a meeting since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

18. Hoffman discloses using a bulletin board, easel or clipboard for organizing notes that are removably affixed to provide an interactive function. (C1; L6-13). Hoffman also discloses that a pre-printed panel including an hourly schedule grid (C4; L48-52) and that the invention is used for scheduling and project management (C5; L7-11). Thus, Hoffman's system provides for placing the notes in a desired order. It is obvious that dependencies and numbering would be utilized as this would be part of maintaining either a schedule or managing a project.

19. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included organizing notes on a clipboard, as disclosed by Hoffman, in the system of Rhodes for the motivation of providing a means of presenting information in a meeting. Rhodes is directed toward information gathering during meetings, presentations and conferences (P[0023]). It is obvious that a board, such as disclosed by Hoffman, would be used as a presentation medium where the displayed information is organized for ease of comprehension.

20. Further, it would have been obvious to one of ordinary skill in the art to include Hoffman's bulletin board for organizing notes with Rhodes' use of barcodes for tracking information in a meeting since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. **Claims 3, 4, 30 and 31:** Spain does not disclose computer connected to the Internet, however, the Examiner takes **Official Notice** that the Internet is old and well known. It is obvious to connect a plurality of computers via a network such as the Internet in order to share resources, such as printers and information.

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the Internet in the system disclosed by Spain, for the motivation of providing remote users with a means of having bar code labels printed. For example, a remote user could send an e-mail via the Internet with instructions regarding bar coded labels to be generated.

23. **Claim 9:** Spain does not disclose displaying a computer image of the notes on a screen.

24. Rhodes, however, discloses video information capture device for capturing output from a projector. (P[0030] and Fig. 6B).

25. It would have been obvious to one of ordinary skill in the art to combine barcode labeling as taught by Spain, with video information capture as taught by Rhodes since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

26. **Claims 11 and 12:** Spain discloses that the computer uses WINDOWS (C4; L17), but does not discloses EXCEL, Word or Project, however, it is obvious to expand Spain to include specific software applications because these applications are old and well known for storing data. Spain would be motivated to use Word to storage various text (i.e., note information) that is used to generate barcodes that are routinely used.

27. **Claims 18 and 27:** Spain does not disclose a flip chart for receiving the notes.

28. Hoffman discloses using a bulletin board, easel or clipboard for organizing notes that are removably affixed to provide an interactive function. (C1; L6-13).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included organizing notes on a clipboard, as disclosed by Hoffman, in the system of Rhodes for the motivation of providing a means of presenting information in a meeting. Rhodes is directed toward information gathering during meetings, presentations and conferences (P[0023]). It is obvious that a board such as disclosed by Hoffman would be used as a presentation medium where the displayed information is organized for each of comprehension.

30. **Claims 32 and 33:** Spain discloses a label with 7 user-defined fields, including textual description. (Fig. 1B). Spain does not disclose field names, such as *note category, user filed, duration, owner identification* and *dependency*.

31. However, these differences are only found in the **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The note information would be generated regardless of the names of fields for the information.** Thus, this descriptive data will not

distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included field names because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of a data field name does not patentably distinguish the claimed invention.

33. **Claims 13, 15-17, 19-25 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spain (US Pat. No. 6,056,195), in view of Rhodes (US Pub. No. 2004/0153969).

34. **Claims 13, 15, 16, 17, 19, 20, 23 and 24:** Spain discloses

- *a computer keyboard* and a *processor* (C2; L46-53)
- *receiving discrete portions of information using the input device and formatting each of the discrete portions of information as an output, wherein each output includes a visually perceptible version of each discrete portion of the information and a computer readable symbology of each discrete portion of the information* (Fig. 1A; comprises alpha-numeric text (i.e., a textual description)).

35. Spain further discloses a printer and adhesive-backed paper. (C3; L33-35 and C3; L67 – C4; L5).

36. Spain does not disclose *a meeting*; *an input device* or *two-dimensional barcoding.*

37. Rhodes discloses a note taking system that incorporates information captured from the event (i.e. a meeting) that a user would like to integrate with the user's notes. (Abstract). Information can be captured by scanning barcodes (i.e., *input device)* printed on paper notes to access electronic information corresponding to the barcode. The information is output to the user's device. (P[0121]). The user's note taking device is used to read a barcode. (P[0050]). The system allows a user to capture information to integrate (i.e., place into a selected computer application) with the user's notes. (P[0041], [0123-0124] and Fig. 6B).

38. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of the printed barcode labels in a meeting environment, as disclosed by Rhodes in the system disclosed by Spain, for the motivation of providing an additional use of barcoded labels. It is obvious that the system of Rhodes relies on barcoding technology to create the barcodes associated with the electronic content. Therefore, it is obvious that the systems of Spain and Rhodes can be combined to create barcoded labels for a meeting environment.

39. Further, it would have been obvious to one of ordinary skill in the art to include Spain's system of generating label media comprising barcodes and text with Rhodes' use of barcodes for tracking information in a meeting since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

40. Spain discloses selecting a bar code standard from a plurality of bar code standards (C3; L5-7), therefore, it is obvious that a two-dimensional standard would be available for selection because it is an old and well known major barcoding symbology.

41. **Claims 21 and 22:** Spain discloses a computer (Fig. 2A) but not a network, however, the Examiner takes **Official Notice** that the Internet is old and well known. It is obvious to connect a plurality of computers via a network such as the Internet in order to share resources, such as printers and information.

42. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the Internet in the system disclosed by Spain, for the motivation of providing remote users with a means of having bar code labels printed. For example, a remote user could send an e-mail via the Internet with instructions regarding bar coded labels to be generated.

43. **Claims 25 and 28:** Spain discloses a printer and a computer (Fig. 2A) for generating labels having text and associated barcode (Fig. 1A). Spain does not disclose a computer network, a plurality of computers or a scanner.

44. Rhodes discloses a note taking system that incorporates information captured from the event (i.e. a meeting) that a user would like to integrate with the user's notes. (Abstract). Information can be captured by scanning barcodes printed on paper notes to access electronic information corresponding to the barcode. The information is output to the user's device. (P[0121]). The user's note taking device is used to read a barcode. (P[0050]). The system allows a user to capture information to integrate (i.e., place into a selected computer application) with the user's notes. (P[0041], [0123-0124] and Fig. 6B). Rhodes further discloses a video information capture device for capturing output from a projector. (P[0030] and Fig. 6B).

45. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of the printed barcode labels in a meeting environment, as disclosed by Rhodes in the system disclosed by Spain, for the motivation of providing an additional use of barcoded labels. It is obvious that the system of Rhodes relies on barcoding technology to create the barcodes associated with the electronic content. Therefore, it is obvious that the systems of Spain and Rhodes can be combined to create barcoded labels for a meeting environment.

46. Further, it would have been obvious to one of ordinary skill in the art to include Spain's system of generating label media comprising barcodes and text with Rhodes' use of barcodes for tracking information in a meeting since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

47. The Examiner takes **Official Notice** that the Internet is old and well known. It is obvious to connect a plurality of computers via a network such as the Internet in order to share resources, such as printers and information.

48. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the Internet in the system disclosed by Spain, for the motivation of providing remote users with a means of having bar code labels printed. For example, a remote user could send an e-mail via the Internet with instructions regarding bar coded labels to be generated.

Response to Arguments

49. Applicant's arguments filed January 21, 2009 have been fully considered but they are not persuasive.

50. Applicant asserts that Spain teaches away from "moving" and "organizing" notes because the labels taught by Spain are configured to be permanently attached to the goods, and therefore a modification to Spain would render the prior art unsatisfactory for it's intended use. Applicant argues that Post-It notes labels would render Spain unsatisfactory for use.

51. The Examiner points out that Applicant's claims (with the exception of claim 27, see 112, second paragraph rejection) requires printing notes on an adhesive-backed paper note. Spain teaches that labels include tags that can be applied to the product or its packaging. (C4; L1-2). Spain does not teach that labels are "permanently attached to the goods" and "are note removable", as Applicant states. In contrast, one of ordinary skill in the art recognizes that many labels are designed to be removed. Consumers routinely remove adhesive-backed labels from the products that they purchase. The Examiner notes that Applicant does not argue Spain's system of generating labels that contain textual information and its duplicative barcoded symbology.

52. Rhodes teaches that use of bar code readers to capture information during a meeting, thus disclosing scanning and placing the information in a computer application where barcoding in used in the context of a meeting, thus demonstrating the ease of transferring information using barcodes. Rhodes was not applied to teach the generation of a note with barcoding.

53. The Examiner maintains that the combination of Spain and Rhodes is proper in that both use barcoding technology to transfer information and that they both disclose old and well known technologies that are useable together.

54. Applicant argues that Hoffman teaches away from the use of printed labels because users can record note information with a marker. The Examiner contends that the old and well known inventions of pens, markers and pencils do not preclude that employment of pre-printed information from being organized and is therefore not persuaded that Hoffman teaches away from the use of pre-printed notes in its organization system.

55. Although the Examiner has applied art to the intended use of the information ("in a meeting"), this recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

56. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

57. The Examiner acknowledges that as a result of Applicant's silence on the Official Notice regarding the Internet, Examiner's statement is taken to be admitted prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/JOHN G WEISS/
Supervisory Patent Examiner, Art Unit 3629